

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM G. O'BRIEN
and GILBERT J. SLOAN

Appeal No. 1997-3123
Application 08/231,964

ON BRIEF

Before KIMLIN, WARREN and OWENS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing view of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain the rejection of appealed claims 35 through 53, all of the claims in the application, under 35 U.S.C. § 103 over Pavia et al. (Pavia).¹ Indeed, the examiner has failed to make out a *prima facie* case of obviousness of the claimed method or process encompassed by any of

¹ Answer, pages 3-5. The citation of Pavia in the answer (page 3) does not specify the pages relied on, which, from the sole copy in the record, appear to be pages 505-16, that is, all of "Technique 3 Crystallization: The Purification of Solids." It appears that the publication date of this reference is 1976 as cited on the PTO 892 attached to Paper No. 6 in parent application 08/028,773.

the appealed claims. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998) (“hindsight” is inferred when the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellants’ claimed invention); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988) (“The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success viewed in the light of the prior art. [Citations omitted.] Both the suggestion and the expectation of success must be founded in the prior art, not in applicant’s disclosure.”).

The plain language of, for example, independent claims 35, 36 and 40, and dependent claim 47, clearly specifies “[a] solvent-*free* method” or “process,” which emphasized term would be broadly interpreted by one of ordinary skill in this art in light of the written description of appellants’ specification to mean simply that *no* solvent is added during the course of the method or process, which is in keeping with the common dictionary meaning of the term “free” in this context.² *See generally, In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The “solvent-free” claims further specify “melting the lactide mixture” as an initial step. Thus, the only solvent which would be present is the “small amounts of solvents [in the lactide] . . . remaining from previous processing steps” (specification, page 2, lines 15-17).³ The other claims, for example, claim 45, which would include any

² See the definition of “free” in any dictionary. *See, e.g., In re Morris*, 127 F.3d 1048, 1055-56, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). We find that appellants specifically define only the phrase “*substantially* solvent free purification and recovery process” in the written description in the specification (page 5, lines 4-9). If this phrase with the emphasized term of degree did appear in an appealed claim, it would permit the inclusion of solvents in the claimed process to the extent indicated in the definition in the specification. *Cf. York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572-73, 40 USPQ2d 1619, 1622-23 (Fed. Cir. 1996) (“In this case, the patent discloses no novel use of claim words. Ordinarily, therefore, ‘substantially’ means ‘considerable in . . . extent,’ *American Heritage Dictionary Second College Edition* 1213 (2d ed. 1982), or ‘largely but not wholly that which is specified,’ *Webster’s Ninth New Collegiate Dictionary* 1176 (9th ed. 1983).”).

³ *Cf. In re Marosi*, 710 F.2d 799, 802-03, 218 USPQ 289, 292 (Fed. Cir. 1983) (the generally guidelines in appellants’ specification with respect to the term “essentially free of alkali metal” permitted

amount of solvent in view of the transitional term “comprising,” *see In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”), clearly specify “melt recrystallization of lactide” with “heating lactide to a temperature sufficient to form a melt” as the initial step.

As pointed out by appellants (e.g., brief, page 3, last full sentence), the examiner has not established on the record that the claimed methods and processes as a whole, including each of the specified limitations thereof, for example, each of the specified steps, would have been found in Pavia by one of ordinary skill in this art. Indeed, the examiner admits that “Pavia relates specifically to solvent crystallization” and has never explained how this method includes, *inter alia*, a step of “melting the lactide mixture” or “heating lactide to a temperature sufficient to form a melt.” Thus, even if it may be said that the examiner established a *prima facie* case in the first instance, appellants certainly carried the burden of establishing to the contrary by pointing out that Pavia requires a solvent for the process of purification by crystallization taught therein, and would have taught away from forming a melt of the lactide (brief, pages 4-5). Appellants further rely on the Sloan declaration and on the Wynn article in these respects (brief, pages 8-9).⁴ Thus, appellants’ response shifted the burden back to the examiner to again establish a *prima facie* case on the record as a whole in order to maintain the ground of rejection. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Because the examiner has not established on the record as a whole, including consideration of the Sloan declaration and the Wynn article in light of appellants’ arguments, why one of ordinary skill in this art would have found in Pavia the suggestion to modify the solvent crystallization process thereof with the reasonable expectation of arriving at a melt crystallization process, which can be solvent-free, it

a person of ordinary skill in the art to “draw the line between unavoidable impurities in starting materials and essential ingredients”).

⁴ The Sloan declaration was filed June 10, 1994 (Paper No. 15) and the Wynn article is cited in the specification (page 3, lines 15-20). Neither of these documents was discussed by the examiner in the answer.

is inescapable that, on this record, the only direction to the claimed invention resides in appellants' specification. *See Rouffet, supra; Dow Chem., supra.*

The examiner's decision is reversed.

Reversed

EDWARD C. KIMLIN
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

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